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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,959	05/24/2000	David I. Durst	TDT-207	6121
7590 03/15/2006				
Steven M. Hoffberg, Esq. MILDE, HOFFBERG & MACKLIN, LLP Suite 460 10 Bank Street White Plains, NY 10606			EXAMINER ZAND, KAMBIZ	
			ART UNIT 2132	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,959

Applicant(s)

DURST ET AL.

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-21 and 41-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 and 41-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

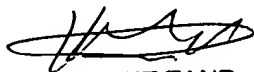
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 1-17 and 29-40 have been cancelled.
4. Claims 22-28 are withdrawn.
5. Claim 41 has been amended.
6. New claims 46-59 have been added.
7. Claims 18-21 and 41-59 are pending.

Response to Arguments

8. Applicant's arguments filed 01/03/2006 have been fully considered and they are persuasive with respect to claims 18-20 and 47.

As per Applicant's arguments that Li do not disclose hashing or ciphering or secret key, examiner makes the following remarks:

Li disclose encoding (see abstract; summary of the invention and other parts of the Li's disclosure including in some of the claims). Therefore previous examiner has correctly disclosed the encoding. Examiner considers Li's encoding to correspond to enciphering. Further more Applicant have admitted that hashing or digital signature or enciphering or encoding are prior art on page 25-28 of Applicant's disclosure.

Therefore use of such methods for encryption is well known in the art. The question is if Applicant's arguments with respect to use of hash in applicant's method steps or system or apparatus or computer readable medium product is an improvement or novel factor over prior art's methods and systems. Applicant has not provided strong arguments with respect to such a notion and only refers to absent of the phrase "hash" in the Li's disclosure. However Hash in a broadest interpretation is an encoding method. Even if Examiner would accept applicant's arguments, the claims would still be reject able based on Applicant Admittance that Hash is a prior art method for encrypting data.

Therefore Examiner strongly suggests Applicant to disclose the method steps of generating a hash function in specific terms that overcomes Applicant's Admittance disclosure of hash and Li's encoding scheme if such a method is the main part of the invention, and if it is presented in a manner that do not require further search and consideration.

Examiner also would reconsider if Applicant provides new arguments having considered examiner's above remarks.

- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "secret key", "enciphering") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- Please see ex- examiner's previous rejection below. Claims 46-59 have been grouped with the previous claims.

Claim Rejections - 35 USC § 103

9. **Claims 18-21 and 43-59** are rejected under 35 U.S.C. 103(a) as being unpatentable over LI (5,549,953) in view of Waters (5,572,589).

Referring to the instant claims, Li discloses an optical recording media having Optically variable security properties (see abstract and Fig.1). In Fig. 26 Li show the Pattern applied to the recording medium. Li teaches that the position of the reflection Peaks (i.e. pattern) depend on the phase thickness, which is given by equation 1 (see column 6). Equation produces a cipher, which defines the pattern on the recording medium. The produced cipher meets the limitation hash being formed from a respective data pattern". Li, however, does not explicitly teach that the data pattern is created on the disc in a form of random fiber or molded pattern.

13. Referring to the instant claims, Waters discloses a method for minimizing Counterfeiting of CD-ROMS and authenticating users of CD-ROMS. In accordance with the first aspect of the present invention, a method of serializing a disc involves Physically damaging a portion of the disc to create a pattern of damage. The pattern of damage is encoded in an identifying value and the disc is marked with the

identifying value to distinguish the disc from other discs (see column 1, lines 25-35).

Walters also teaches authenticating the disc based on the pattern (see Fig. 9).

Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to create the optical recording media having optically variable security properties of Li (such encoding), by damaging (i.e. changing) the fiber pattern of the optical disc as taught in Walters. One of ordinary skill in the art would have been motivated to create the optical recording media having optically variable security properties of Li, by changing the fiber pattern of the optical disc as taught in Walters for authenticating the disc based on the pattern (see Walters, column 1, lines 25-35 and Fig. 9). Also using the hashing, digital signature in the encoding method of the above steps are well known as Applicant have disclosed on pages 25-28 of the Applicant's disclosure.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned are 571-272-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAMBIZ ZAND
PRIMARY EXAMINER

03/11/2006

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